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U.S. 11/11/07

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,788	08/08/2001	Arthur Yuichi Tsubaki	1348-1010	2798
32376	7590	10/04/2007		
LAWRENCE R. YOUST 2001 Ross Avenue Suite 3000 DALLAS, TX 75201			EXAMINER ELAHEE, MD S	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/924,788

Applicant(s)

TSUBAKI ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/11/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 15-21, 23-30 and 32-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 15-21, 23-30 and 32-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 07/11/2007. Claims 1-4,6-13,15-21,23-30,32-53 are pending. Claims 5,14,22 and 31 have been previously cancelled. Claim 53 has been added.

Response to Arguments

2. Applicant's arguments mailed on 07/11/2007 Remarks regarding claim 53 has been considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

3. The arguments filed in the 07/11/2007 Remarks regarding claim 29 rejected by Barnett '223 and regarding claims 1-4,6-13,15-21,23-30,32-52 rejected by Barnett '892 have been fully considered but they are not persuasive because of the following:

4. Rejection over Barnett '223:

The applicant argues on pages 18, 19 that Barnett '223 does not teach a "cellular-network based position locator circuit". Examiner disagrees with this argument. Barnett '223 discloses that radio receiver 2 and host system 4 communicates using a wireless medium such a mobile telephone network (see col.4, lines 35-38). Since mobile telephone is another name of cell phone and cellular network is controlled by cellular switching offices which is called Mobile Telephone

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Switching Offices (or MTSO) (see attached document, page 159, Newton's Telecom Dictionary, 19 th edition by Harry Newton), the mobile telephone of Barnett '223 MUST use a cellular-network.

Barnett '223 further discloses that the host system uses the postal code in a programming request to identify the geographic location of a frequency scanning radio receiver (col.5, lines 47-49). Thus, it is clear that the host system performs the feature of identifying the location of the receiver as the claimed "cellular-network based position locator circuit". Therefore, examiner interprets the host system as "cellular-network based position locator circuit".

Regarding 103 rejection, on pages 22 and 23 the applicant further argues that there is no suggestion or motivation to combine Barnett '223 and McLellan, because there is no success of the combination. Examiner respectfully disagrees with this argument for the following reasons:

Barnett teaches a host system [i.e., cellular network based position locator circuit] that identifies the location of the receiver (col.4, lines 24-29, col.5, lines 47-49) and the host system communicates through satellite network (col.4, lines 35-38). McLellan teaches a GPS receiver (i.e., position locator circuit) (abstract; page 1, paragraph 0004) for identifying the location of the receiver. Thus the combination of Barnett '223 and McLellan provides reason for one of ordinary skill in the art to incorporate a GPS based position locator circuit in order to provide a GPS based receiver such that the receiver does not need modem or transmitting function to a host system for locating the receiver. The modification enables the radio receiver to identify the location of the receiver.

Thus the rejection of the claims in view of Barnett '223 and McLellan remain.

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5. Conception and Diligence:

Examiner does not agree with the arguments in the 07/11/2007 Remarks that the evidence submitted by showing conception and diligence overcomes the effective date of the Barnett et al. (U.S. Pub. No. 2001/0006892) reference. The reasons have been already shown in the previous office action mailed 09/07/2006.

6. Rejection over Barnett '892:

The applicant argues on pages 20-22 that Barnett '892 does not teach a "cellular-network based position locator circuit". Examiner disagrees with this argument. Barnett '892 discloses that radio receiver 2 and host system 4 communicates using a wireless medium such a mobile telephone network (see page 3, paragraph 0039). Since mobile telephone is another name of cell phone and cellular network is controlled by cellular switching offices which is called Mobile Telephone Switching Offices (or MTSO) (see attached document, page 159, Newton's Telecom Dictionary, 19 th edition by Harry Newton), the mobile telephone of Barnett '892 MUST use a cellular-network.

Barnett '892 further discloses that the host system uses the postal code in a programming request to identify the geographic location of a frequency scanning radio receiver (see page 4, paragraph 0046). Thus, it is clear that the host system performs the feature of identifying the location of the receiver as the claimed "cellular-network based position locator circuit". Therefore, examiner interprets the host system as "cellular-network based position locator circuit".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 29 is rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (U.S. Patent No. 6,192,223).

Regarding claim 29, with respect to fig.1, 3-9, Barnett teaches a programmable frequency scanning radio receiver comprising:

a receiver that receives radio frequency transmissions at a plurality of discrete frequencies (abstract; fig.6; col.2, lines 15-18).

Barnett further teaches a host system [i.e., cellular network based position locator circuit] that identifies the location of the receiver (col.4, lines 24-29, 35-38, col.5, lines 47-49).

Barnett further teaches a communication device that communicates locally with a computing device including a database of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties and a parse engine 36 [i.e., compiler circuit] that identifies transmitting parties of interest from the plurality of transmitting parties based upon the location of the receiver (fig.3, 4; col.8, lines 5-38), the communication device transmitting the location information to the computing device and receiving frequency data

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relating to the transmitting parties of interest from the computing device (abstract; fig.3,4; col.2, lines 9-14, 35-37, 45-47, 61-67, col.3, lines 1-4, col.8, lines 5-38).

Barnett further teaches a memory that stores frequency data corresponding to the transmitting parties of interest (col.2, lines 15-21).

Barnett further teaches a processing circuit coupled to the receiver, the host system, the communication device and the memory that stores the frequency data in the memory and controls the receiver to monitor transmissions at the frequencies of the transmitting parties of interest (abstract; fig.3, 6; col.2, lines 9-14, 15-30, 35-37, 45-47, col.4, lines 24-29, col.5, lines 47-49, col.8, lines 5-24, col.10, lines 23-35).

9. Claims 1-4, 6-13, 15-17, 19-21, 23-25, 27-30, 32-34, 36-41 and 43-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (U.S. Pub. No. 2001/0006892).

Regarding claims 1, 10, 21, 29, 30, with respect to fig.1, 3-7, 10-18, Barnett teaches a programmable frequency scanning radio receiver comprising:

a receiver that receives radio frequency transmissions at a plurality of discrete frequencies (abstract; fig.6; page 1, paragraph 0011, page 2, paragraph 0015);

Barnett further teaches a database of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties (abstract; page 1, paragraphs 0011-0013, page 2, paragraph 0015);

Barnett further teaches a GPS receiver (i.e., GPS based position locator circuit) that identifies the location of the receiver (page 9, paragraphs 0106, 0109, page 10, paragraph 0110, page 11, paragraph 0120);

Barnett further teaches a parse engine 36 (i.e., compiler circuit) that identifies transmitting parties of interest from the plurality of transmitting parties based upon the location of the receiver (fig.3, 4; page 5, paragraphs 0061, 0062);

Barnett further teaches a memory that stores frequency data corresponding to the transmitting parties of interest (page 1, paragraphs 0011, 0012, page 2, paragraphs 0014, 0015);

Barnett further teaches a processing circuit coupled to the receiver, the database, the host system, the parse engine 36 and the memory that provides the location of the receiver to the compiler circuit, stores the frequency data in the memory and controls the receiver to monitor transmissions at the frequencies of the transmitting parties of interest (abstract; fig.3, 6; page 1, paragraph 0011-page 2, paragraph 0015, page 3, paragraph 0038, page 4, paragraph 0046, page 5, paragraph 0061, page 6, paragraph 0083).

Regarding claims 2, 11 and 39, Barnett teaches that the database of frequency data is stored within a second memory internal to the frequency scanning radio receiver (page 9, paragraph 0109).

Regarding claims 3, 12 and 40, Barnett teaches that the database of frequency data is stored on a memory device that is removably insertable into the frequency scanning radio receiver (page 9, paragraph 0109).

Regarding claims 4, 13 and 45, Barnett teaches that the database of frequency data further comprises frequency data relating to at least one usage type (page 9, paragraph 0109).

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Regarding claims 6, 15 and 23, Barnett teaches that the position locator circuit is a cellular network based circuit (page 3, paragraph 0039, page 4, paragraph 0046).

Regarding claims 7, 16, 24 and 32, Barnett teaches that an input device coupled to the processing circuit (fig.6; page 7, paragraph 0086).

Regarding claims 8 and 33, Barnett teaches that the position locator circuit receives position information input into the input device (fig.6; page 7, paragraph 0086).

Regarding claims 9, 17, 25, 34 and 51, Barnett teaches that a display coupled to the processing circuit that displays identification data relating to the transmitting parties of interest (fig.6; page 7, paragraph 0087).

Regarding claims 19, 27 and 36, Barnett teaches that the communication device communicates via short range radio communication (page 1, paragraphs 0011, 0012, 0014, 0015).

Regarding claims 20, 28 and 37, Barnett teaches that the communication device is coupled to the position locating device via a data cable (fig.1; page 3, paragraphs 0037, 0038).

Claim 38 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches maintaining a data base (i.e., non remote database) of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties (abstract; page 1, paragraphs 0011- 0013, page 2, paragraph 0015).

Regarding claim 41, Barnett teaches that maintaining the data base (i.e., non remote database) of frequency data in a local device communicably coupled to the frequency scanning radio receiver (page 1, paragraphs 0011- 0013, page 2, paragraph 0015, page 9, paragraph 0109).

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Claim 43 is rejected for the same reasons as discussed above with respect to claim 19. Furthermore, Barnett further teaches communicating between the host system device (i.e., local device) and the frequency scanning radio receiver (fig. 1; page 3, paragraph 0038).

Claim 44 is rejected for the same reasons as discussed above with respect to claims 20 and 43.

Claims 46 and 47 are rejected for the same reasons as discussed above with respect to claims 1 and 5.

Claims 48 and 49 are rejected for the same reasons as discussed above with respect to claims 1 and 6.

Claim 50 is rejected for the same reasons as discussed above with respect to claims 1 and 8.

Claim 52 is rejected for the same reasons as discussed above with respect to claims 1 and 38.

Claim 53 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches a module operable to download proper frequencies to the memory based upon the location of the receiver (page 1, paragraph 0011-page 2, paragraph 0015, page 4, paragraph 0046, page 5, paragraphs 0061, 0066).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 18, 26, 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (U.S. Pub. No. 2001/0006892) in view of Lyons (U.S. Patent No. 6,282,412).

Regarding claims 18, 26, 35 and 42, Barnett does not specifically teach "the communication device communicates via infrared communication". Lyons teaches that the

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communication device communicates via infrared communication (col.3, lines 57-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barnett to allow the communication device communicating via infrared communication as taught by Lyons. The motivation for the modification is to have doing so in order to allow data to be entered into the memory from modem remotely using a known data transmission protocol.

14. Claims 1, 10, 21, 38, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (U.S. Patent No. 6,192,223) in view of McLellan (European Pub. No. EP 0964514 A1).

Claims 1, 10 and 21 are rejected for the same reasons as discussed above with respect to claim 29. Furthermore, Barnett teaches a host system [i.e., cellular network based position locator circuit] that identifies the location of the receiver (col.4, lines 24-29, col.5, lines 47-49) and the host system communicates through satellite network (col.4, lines 35-38). However, Barnett does not specifically teach a GPS based position locator circuit. McLellan teaches a GPS receiver (i.e., position locator circuit) (abstract; page 1, paragraph 0004). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barnett to incorporate a GPS based position locator circuit in order to provide a GPS based receiver such that the receiver does not need modem or transmitting function to a host system for locating the receiver.

Claim 38 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches maintaining a data base [i.e., non remote database] of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties (abstract; col.2, lines 9-14, 35-37, 45-47, 61-67, col.3, lines 1-4).

Claim 52 is rejected for the same reasons as discussed above with respect to claims 1 and 38.

Claim 53 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches a module operable to download proper frequencies to the memory based upon the location of the receiver (col.2, lines 9-21, 35-37, 45-47, 61-67, col.3, lines 1-4, col.8, lines 5-38, col.9, lines 4-10).

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Md. Shafiqul Alam Elahie

MD SHAFIUL ALAM ELAHEE

Examiner

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September 26, 2007